REMARKS/ARGUMENTS

Claims 1-28 are pending in this Application.

Claims 1-4, 6-13, 15, 21-28 are currently amended. Claims 5 and 18 have been canceled. New claim 33 has been added. Applicants submit that support for the claim amendments and the newly added claims can be found throughout the specification and the drawings.

Claims 1-4, 6-17, 19-28, and 33 are now pending in the Application after entry of this Amendment. No new matter has been entered.

In the Office Action, claims 1-7, 10-12, and 15-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 20020111911 A1 to Kennedy et al. (hereinafter "Kennedy"), in view of U.S. Patent No. 6,446,093 to Tabuchi (hereinafter "Tabuchi"). Claims 8, 9, 13, 14 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy, in view of Tabuchi, and further in view of U.S. Patent No. 6,250,481 to Heddaya et al. (hereinafter "Heddaya").

Claim Rejections Under 35 U.S. C. § 103(a)

Applicants respectfully traverse the rejections to claims 1-7, 10-12, and 15-27 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Kennedy in view of Tabuchi. The Office Action alleges that the combination of references teach or disclose all of the claimed limitations of the corresponding claims and that one having ordinary skill in that art at the time of the invention would have been motivated to incorporate the teachings of Kennedy with the teachings of Tabuchi.

Applicants, however, respectfully submit that a prima facie case of obviousness has not been established by the evidence presented in the Office Action. In order to establish a prima facie showing of obviousness, three requirements must be satisfied: all limitations of a pending claim must be expressly or impliedly disclosed by prior art references; there must be a suggestion or motivation in the art for the ordinarily skilled artisan to combine the limitations; and there must be a reasonable expectation of success in making such a combination. (M.P.E.P. § 2143).

Applicants respectfully submit that Kennedy and Tabuchi, either individually or in combination, fail to teach or suggest at least one of the claim limitations recited in each of claims 1-7, 10-12, and 15-27.

Claim 1

Amended claim 1 recites the feature of "in response to the commit request, transmitting a copy of the first document from the first server to the second server identified by the distribution list, the first server and the second server thereafter responsive to one or more download requests for one or more copies of the first document, the download requests containing the first information.

As recited above, a copy of a document is transmitted to a first server and a second server identified by a distribution list. The first server <u>and</u> the second server thereafter become responsive to download requests for the first document where the download requests include the first information (emphasis added). Applicants respectfully submit that Kennedy and Tabuchi, either individually or in combination, fail to teach or suggest at least the above recited feature of claim 1.

The Office Action alleges that Kennedy discloses the above-recited feature in paragraphs [0038-0039], [0045], [0055], and [0060] of Kennedy stating that Kennedy discloses the distributing of a document to recipients in accordance with the distribution list associated with the document of Kennedy. Applicants respectfully disagree.

As recited in claim 1, the first server distributes a document to a second server. Both the first server and the second server become responsive to download requests for one or more copies of the document. These download requests recited in claim 1 include the information indicating that the first server is configured to create the document in the original document format. Applicants respectfully submit that Kennedy fails to teach or suggest that the document distribution system controller (hereinafter the "DDSC") or any other server of Kennedy becomes responsive to download requests for one or more copies of the document as the first server and the second server recited in claim 1.

   Paragraph [0038] in Kennedy merely discloses that when a distribution request in Kennedy is submitted to the DDSC, the DDSC compiles a list of distribution options for the document. The list of distribution options in Kennedy is then presented to the user. Thus, paragraph [0038] does not teach or suggest that the DDSC becomes responsive to download requests from one or more distribution servers for one or more copies of the document as the first server recited in claim 1.

   Paragraph [0039] in Kennedy merely discloses one example where the distribution options are presented to the user via a user interface. Thus, paragraph [0039] does not teach or suggest that the DDSC becomes responsive to download requests from one or more distribution servers for one or more copies of the document as the first server recited in claim 1.

   Paragraph [0045] in Kennedy merely discloses that according to FIG. 5, the user submits the distribution selection for a document. The DDSC then routes or distributes the document to one or more service providers. Some examples of the one or more services providers are a printer (FIG. 5, elements 221 and 241), an e-mail application (FIG. 5, elements 222 and 242), and a print service provider (FIG. 5, elements 223 and 243). However, these services (or any servers that provide them) and the examples provided in Kennedy are substantially different from the first server and the second server recited in claim 1 that become responsive to download requests for one or more copies of the document.

   Paragraph [0055] in Kennedy merely discloses that according to FIG. 3, the user submits a distribution request and a data file to the DDSC via a communications network. Thus, paragraph [0055] does not teach or suggest that the DDSC becomes responsive to download requests for one or more copies of the document as the first server and the second server recited in claim 1.

   Paragraph [0060] in Kennedy again merely discloses that the DDSC again routes or distributes the data file of paragraph [0055] to one or more document distribution providers. Paragraph [0060] explains that the DDSC routes the data file and distribution instructions, if provided, to the document distribution provides that fulfill distribution options selected by the user. Thereafter, the document distribution providers (not the DDSC) "distribute the document according to the options provided by the user." Paragraph [0060] does not teach or suggest that

Appl. No. 10/085,569
Amdt. dated September 14, 2007
Reply to Office Action of April 3, 2007

PATENT

the DDSC becomes responsive to download requests for one or more copies of the document as the first server and the second server as recited in claim 1. Moreover, Kennedy simply states that the document distribution providers "distribute the document." However, simply distributing a document does not necessary teach or suggest that the document distribution providers become responsive to download requests for one or more copies of the document as the first server and the second server as recited in claim 1.

Accordingly, the routing and distributing of Kennedy to the recipient in accordance with the distribution list associated with the document as alleged in the Office Action is substantially different from the method recited in claim 1 of distributing documents where in response to a commit request, a copy of a first document is transmitted from a first server to a second server identified by a distribution list, the first server and the second server thereafter responsive to one or more download requests for one or more copies of the first document, the download requests containing the first information.

Applicants note that the new grounds of rejection by the Examiner solely focus on the deficiencies of Kennedy in regard to failing to teach or suggest "producing a first identifier adapted for association with a first document, the first identifier including first information indicative of a first server configured to create the first document in an original document format" as recited in claim 1. The Office Action merely relies upon Tabuchi for its teaching of a document object identifier, and alleges that the document object identifier of Tabuchi discloses the above-recited feature. However, Tabuchi also fails to cure the above discussed deficiencies of Kennedy. Neither Kennedy nor Tabuchi teach or suggest the feature of "in response to the commit request, transmitting a copy of the first document from the first server to the second server identified by the distribution list, the first server and the second server thereafter responsive to one or more download requests for one or more copies of the first document, the download requests containing the first information" as recited in claim 1.

Furthermore, Tabuchi merely disclose that a document server may store data indicative of a correspondence between an identifier of a document and a client holding the latest edits. (Tabuchi: Col. 32, lines 64-67). Applicants respectfully submit that a correspondence between an identifier of a document and a client holding the latest edits is substantially different

Appl. No. 10/085,569
Amdt. dated September 14, 2007
Reply to Office Action of April 3, 2007

PATENT

from a "first identifier including first information indicative of a first server configured to create the first document in an original document format" as recited in claim 1. Moreover, the document identifier in the document object of Tabuchi merely identifies the document (FIG. 11A, Col. 16, lines 20-23).

Accordingly, Applicants respectfully submit that Kennedy and Tabuchi, either individually or in combination, fail to teach or suggest each and every claim limitation recited in claim 1. Thus, Applicants respectfully submit that claim 1 is allowable over the cited references.

Claims 2-4, 6-17, 19-28

Applicants respectfully submit that independent claims 1, 10, 15, and 24 are allowable for at least a similar rationale as discussed above for the allowability of claim 1, and others. Applicants respectfully submit that the dependent claims 2-4 and 6-9, 11-14, 16-17 and 19-23, and 25-28 that depend directly and/or indirectly from the independent claims 1, 10, 15, and 24 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims. Applicants further respectfully submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

In light of the above, Applicants respectfully traverse the rejections to claims 8, 9, 13, 14 and 28 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Kennedy, in view of Tabuchi, and further in view of Heddaya.

New Claim 33

Claim 33 recites a method for distributing documents, comprising:

associating a document identifier with a first document, the document identifier specifying a first server, from one or more servers configured to create documents for distribution, that created the first document;

storing the first document;

receiving a distribution list associated with the first document, the distribution list identifying one or more other servers;

Appl. No. 10/085,569   PATENT
Amdt. dated September 14, 2007
Reply to Office Action of April 3, 2007

in response to receiving a commit request, transmitting the first document from the first server to the one or more other servers identified by the distribution list;

receiving a second document representative of a modified version of the first document;

storing the second document while retaining the first document; and

transmitting the second document to the one or more other servers identified by the distribution list.

Applicants respectfully submit that Kennedy and Tabuchi, either individually or in combination, fail to teach or suggest at least one of the claim limitations recited in claim 33.

For example, claim 33 recites the feature of "associating a document identifier with a first document, the document identifier specifying a first server, from one or more servers configured to create documents for distribution, that created the first document." The Office Action acknowledges that Kennedy fails to disclose a document identifier, and relies on Tabuchi for its alleged teaching of a document identifier. However, the document identifier in Tabuchi (FIG. 11A, Col. 16, lines 20-23) merely identifies the document itself, rather than specifying a first server, from one or more servers configured to create documents for distribution, that created the first document as recited in claim 1.

Thus, Applicants respectfully submit that claim 33 is allowable over the cited references.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

/Sean F. Parmenter/
Sean F. Parmenter
Reg. No. 53,437

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
SFP:m6s
61063022 v1